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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/752,037	12/29/2000	Frank Liebenow	450.317US1	8768

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EXAMINER

LE, KAREN L

ART UNIT PAPER NUMBER

2642

DATE MAILED: 01/20/2004

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/752,037

Applicant(s)

LIEBENOW, FRANK

Examiner

Karen Le

Art Unit

2642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to applicant's response filed on October 8, 2003. Claims 1-50 are now pending in the present application. **This action is made non-final.**

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-43 are rejected under 35 U.S.C. 102(e) as being anticipated by Miller, Jr. (U. S. 6,442,249).

Regarding claims 1, 9, 10, 20, 22-23 Miller teaches a method, a computer readable medium, of handling a call from a caller to a communication device (Fig. 1, item 1), the method comprising:

Receiving the call, determining if the communication device is in a privacy mode (Col. 3, lines 12-13), and if the communication device is in the privacy mode, completing the call if a privacy mode code is entered by the caller (Col. 3, lines 35-44)

If the communication device is in the privacy mode, providing a privacy mode message including a selected privacy override code to the caller (Col.3, 23-34).

Regarding claims 2, 11, 21, 24, 26, 33, and 38 Miller further teaches if the communication device is in the privacy mode, routing the call to a message system if no privacy mode code is entered by the caller (Col. 23-34 and Col. 7, lines 15-16).

Regarding claims 3, 14, 29, and 34 Miller further teaches the privacy mode is selected by a user of the communication device (Col. 7, lines 34-38).

Regarding claims 4, 15, 30, and 43 Miller further teaches communication device is one of a cellular telephone and personal digital assistant (Col. 1, lines 46-48).

Regarding claims 5 and 16 Miller further teaches the method is performed by one of a base station and a switch (Col. 1, lines 46-48).

Regarding claims 6, 17 and 40 Miller further teaches receiving a request from the communication device to place the communication device in the privacy mode (Col. 1, lines 55-56).

Regarding claims 7, 12-13, 18, and 41 Miller further teaches a privacy mode message selected by a user of the communication device and adapted to be provide to the caller prior to completing the call (Col. 7, lines 3-9, Fig. 3b, item 328), and the privacy mode code selected by the user of the communication device (Col. 7, lines 9-13).

Regarding claims 8, 19 and 42 Miller further teaches receiving a request from the communication device to place the communication device out of the privacy mode (Col. 7, lines 13-14).

Regarding claims 25, 31-32, 35-37 and 39 Miller further teaches a system for handling a call from a caller to a user of a communication device comprising:

a data entry device capable of receiving input to cause the communication device to enter a privacy mode (Col. 7, lines 34-38), a memory capable of storing a privacy mode message (Col. 7, lines 3-9), the privacy mode message including a selected privacy override code adapted to be provided to the caller prior to completing the call to the user (Col. 7, lines 3-13), and a receiver capable of completing the call to the user if a privacy mode code is entered by the caller a transmitter capable of completing the call to the user if the communication device is in the privacy mode and the privacy mode code is entered by the caller (Col. 3, lines 35-44).

Regarding claim 27 Miller further teaches the data entry device is a telephone keypad (Col. 7, lines 34-38).

Regarding claims 28, Miller further teaches the privacy mode code comprises at least one keystroke from the data entry device (Col. 3, lines 35-44).

Regarding claims 44-50, further teaches the communication device is in the privacy mode, passing the call to a voice messaging system if the privacy mode code is not entered by the caller, the voice messaging system being capable of recording a message spoken by the caller making the call, blocking completion of the call until the privacy mode code is entered (Col. 3, lines 23-44 and Col. 7, lines 3-16).

Response to Arguments

4. Applicant's arguments with respect to claims 1-50 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

5. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

Hand-delivered responses should be brought to

Crystal Park II, Sixth Floor (Receptionist)

2121 Crystal Drive

Arlington, VA 22202


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen Le whose telephone number is 703-308-4998. The examiner can normally be reached on Monday - Friday from 8:30 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on (703) 305-4731. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9314.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4750.

Karen Le
KLL
January 9, 2004


AHMAD MATAR
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600
